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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,749	09/25/2003	Kevin P. Parker	PRKR-4100	2758

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EXAMINER
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GATES, ERIC ANDREW

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 02/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/670,749	<b>Applicant(s)</b> PARKER, KEVIN P.	
	<b>Examiner</b> Eric A. Gates	<b>Art Unit</b> 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 24-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/29/04; 11/23/05</u> | 6) <input checked="" type="checkbox"/> Other: <u>PTO-1449 1/29/06</u>                  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

- a. Species I, as disclosed in Figures 1-9, drawn to claims 1-23.
- b. Species II, as disclosed in Figures 10-12H, drawn to claims 24-28.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record

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showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Mr. Philip Girard on 7 February 2006, a provisional election was made without traverse to prosecute the invention of Species I, claims 1-23. Affirmation of this election must be made by applicant in replying to this Office action. Claims 24-28 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Claim Objections***

3. Claim 1 is objected to because of the following informalities:

- c. In line 6, "the" should be changed to "that".
- d. In line 15, "for" should be changed to "from".

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Pierson et al. (U.S. Patent 6,010,157).

6. Regarding claim 1, Pierson et al. discloses a book binding apparatus 10 for binding a stack of sheets 12, said apparatus comprising: a first cover element 20 including a first cover section 18 having dimensions that generally correspond to dimensions of the sheets; a first section 48a of pressure sensitive adhesive disposed along a first edge of the first cover section; a first release liner 50a disposed over the first section 48a of pressure sensitive adhesive; a flap member 44 attached to the first cover section 18 and movable between a closed position where the flap member 44 is disposed over at least a portion of said first release liner 50a and an open position where the flap member is positioned away from said first release liner 50a; a second section 48b of pressure sensitive adhesive disposed on a surface of said flap member 44 facing said first release liner 50a; and a second release liner 50b disposed over said second section 48b of pressure sensitive adhesive.

7. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Schaefer (U.S. Patent 5,605,425).

8. Regarding claim 1, Schaefer discloses a book binding apparatus 10 for binding a stack of sheets 30, said apparatus comprising: a first cover element 11 including a first cover section 11 having dimensions that generally correspond to dimensions of the sheets; a first section 20 (portion against 11) of pressure sensitive adhesive disposed along a first edge of the first cover section; a first release liner (not shown, see column 2, lines 32-34) disposed over the first section 20 of pressure sensitive adhesive; a flap

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member 20 attached to the first cover section 11 and movable between a closed position where the flap member 20 is disposed over at least a portion of said first release liner and an open position where the flap member is positioned away from said first release liner; a second section 20 (portion against 30) of pressure sensitive adhesive disposed on a surface of said flap member 20 facing said first release liner; and a second release liner disposed over said second section 20 of pressure sensitive adhesive.

9. Regarding claim 2, Schaefer discloses a second cover element 12 comprising a second cover section 12 having dimensions that generally correspond to dimensions of the sheets; and an elongated spine element 15 having a longitudinal first edge attached to an edge of the second cover section 12 and a longitudinal second edge to be secured by the first section 20 of pressure sensitive adhesive of the first cover section 11 (see figure 1, second edge of 15 at bottom of V of 20), with the spine element 15 including a substrate 15 and an adhesive matrix of heat activated adhesive disposed on the substrate 15 (not shown, see column 2, line 27).

10. Claims 4-5, 12, and 15-22 are rejected under 35 U.S.C. 102(b) as being anticipated by DuCorday (U.S. Patent 4,800,110).

11. Regarding claim 4, DuCorday discloses a method of binding a stack of sheets comprising; providing a first cover element 12 which includes a first cover section 12 and an elongated spine element 14 having a first longitudinal edge attached to an edge of the first cover section 12, with the spine element 14 including a temperature activated adhesive matrix 26; providing a second cover element 60 which includes a second

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cover section 60; positioning the stack of sheets intermediate the first and second cover sections; folding the binder element around an edge of the stack of sheets so that the adhesive matrix 26 is facing an edge of the stack of sheets; subsequent to the folding, securing the spine element to the second cover section (using adhesive 54); and subsequent to said securing, applying heat to the spine element so that molten heat activated adhesive 26 contacts the edge of the stack.

12. Regarding claim 5, DuCorday discloses wherein the securing is carried out using pressure sensitive adhesive 54.

13. Regarding claim 12, DuCorday discloses that the elongated spine element 14 includes a segment of pressure activated adhesive 54 disposed along a second longitudinal edge of the spine element covered by a release liner 56 and wherein the method further includes removing the release liner and the securing includes pressing the spine element against the second cover section 60.

14. Regarding claim 15, DuCorday discloses a book binding apparatus for binding a stack of sheets, said apparatus comprising: a first cover element 112/160 including a folded sheet, with half the folded sheet forming a first cover section 112 having dimensions that generally correspond to dimensions of the sheets of the stack of sheets; and an elongated spine element 116 having a longitudinal first edge attached to the first cover section adjacent a fold in the folded sheet, with the spine element including a substrate and an adhesive matrix 126 of heat activated adhesive disposed on the substrate.

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15. Regarding claim 16, DuCorday discloses wherein the adhesive matrix 126 defines a multiplicity of spaced apart longitudinal grooves that facilitate folding of the spine element.

16. Regarding claim 17, DuCorday discloses wherein the elongated spine element 116 further includes a pressure sensitive adhesive 152 disposed along a longitudinal second edge of the spine element and a release liner (not labeled, see figure 5) disposed over the pressure sensitive adhesive.

17. Regarding claim 18, DuCorday discloses a book binding apparatus 10 for binding a stack of sheets, said apparatus comprising: a cover section 12 having dimensions that generally correspond to dimensions of the sheets; an elongated spine element 16 having a longitudinal first edge attached to a first edge of the first cover section, with the spine element including a substrate and an adhesive matrix 26 of heat activated adhesive disposed on the substrate; and a securing element 14 attached to a second edge of the elongated spine element, opposite the first edge of the elongated spine element, said securing element including a layer of pressure sensitive adhesive 54 and a release liner 56 disposed over the layer of pressure sensitive adhesive.

18. Regarding claim 19, DuCorday discloses a method of binding a stack of sheets comprising; providing a first cover element 10 that includes a cover section 12 having dimensions that generally correspond to dimensions of the sheets and an elongated spine element 16 having a longitudinal first edge attached to a first edge of the cover section, with the spine element including a substrate and an adhesive matrix 26 of heat activated adhesive disposed on the substrate; positioning the first cover element and



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the stack of sheets such that the cover section is disposed adjacent a first side of the stack of sheets; folding the spine element around an edge of the stack of sheets so that the adhesive matrix 26 is facing the edge of the stack; subsequent to the folding, securing a second longitudinal edge of the spine element 16 (using adhesive 52), opposite the first longitudinal edge; and subsequent to the folding, applying heat to the spine element so that molten heat activated adhesive 26 contacts the edge of the stack.

19. Regarding claim 20, DuCorday discloses wherein the securing is carried out using a pressure sensitive adhesive 52.

20. Regarding claim 21, DuCorday discloses wherein the pressure sensitive adhesive 52 is disposed on the first cover element 10.

21. Regarding claim 22, DuCorday discloses providing a second cover element 60 which includes a second cover section 60; prior to the folding, positioning the second cover element relative to the stack of sheets so that the second cover element is disposed opposite a second side of the stack of sheets; and wherein the securing causes that second longitudinal edge of the spine element 16 to be secured to the second cover element 60.

### ***Claim Rejections - 35 USC § 103***

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pierson et al. in view of DuCorday.

24. Regarding claim 2, Pierson et al. discloses a second cover element 16 comprising a second cover section 16 having dimensions that generally correspond to dimensions of the sheets; and an elongated spine element 22 having a longitudinal first edge 46 attached to an edge 56 of the second cover section 16 and a longitudinal second edge 40 to be secured by the first section 48a of pressure sensitive adhesive of the first cover section 18, with the spine element 22 including a substrate 46 and an adhesive matrix 48c disposed on the substrate 46. Pierson et al. does not disclose said adhesive matrix is made of heat activated adhesive.

25. DuCorday teaches the use of an adhesive matrix 26 disposed on the spine 10 for the purpose of providing a strong adhesive bond. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the binding apparatus of Pierson et al. with the adhesive of DuCorday in order to have a binder with stronger adhesion to the sheets to be bound.

26. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schaefer in view of DuCorday (U.S. Patent 4,800,110).

27. Regarding claim 3, Schaefer discloses the invention substantially as claimed, except Pierson et al. does not disclose wherein the adhesive matrix defines a multiplicity of spaced apart longitudinal grooves that facilitate folding of the spine element.

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28. DuCorday teaches the use of spaced apart longitudinal grooves 34/36 on an adhesive matrix 26 for the purpose of facilitating folding of the spine. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the binding apparatus of Schaefer with the grooves of DuCorday in order to have a spine that is more easily shaped.

29. Claims 6 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over DuCorday in view of Ong (U.S. Patent 5,727,816).

30. Regarding claims 6 and 23, DuCorday discloses the invention substantially as claimed, except DuCorday does not disclose wherein the second cover element includes a first segment of pressure activated adhesive covered by a first release liner and wherein the method further includes removing the first release liner and the securing includes pressing spine element against the first segment of pressure activated adhesive.

31. Ong teaches the use of a second cover element 94 that includes a first segment 112 of pressure activated adhesive covered by a first release liner 116 used for the purpose of holding the spine of the sheet of papers 12 in place. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the binding apparatus of DuCorday with the second cover element of Ong in order to have a spine that is held more firmly.

32. Claims 7-11 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over DuCorday in view of Ong and further in view of Schaefer.

33. Regarding claim 7, the modified invention of DuCorday discloses the invention substantially as claimed, except the modified invention of DuCorday does not disclose wherein the second cover element includes a flap member attached to the second cover section movable between an open and a closed position and, subsequent to the pressing, moving the flap member to the closed position so as to cover at least a portion of the spine element.

34. Schaefer teaches the use of a second cover element 12 including a flap element 21 with a covering of pressure sensitive adhesive and a release liner removed prior to attachment (see column 2, lines 32-34), movable between an open and closed position, and, subsequent to pressing to the sheets 30, moving the flap member to the closed position (see figure 2D) so as to cover at least a portion of the spine element 15 (partially covers from the inside at the tip of the V), all for the purpose of providing a protective flap on the bound sheets. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the binding apparatus of DuCorday with the second cover element of Schaefer in order to more firmly hold the sheets in the binder.

35. Regarding claims 8 and 9, the modified invention of DuCorday discloses the invention substantially as claimed.

36. Regarding claims 10-11 and 13-14, the modified invention of DuCorday discloses subsequent to the applying heat, permitting the molten heat activated adhesive to cool so as to produce a bound stack. The modified invention of DuCorday does not disclose subsequently providing a hardcover assembly including first and second relatively rigid

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hardcover sections separated by a spine segment, with the first hardcover section including a first pressure sensitive adhesive layer; exposing only a first portion of the first pressure sensitive adhesive layer; positioning the bound stack and the first hardcover section so that the bound stack comes in contact with the exposed first portion of the first pressure sensitive adhesive layer; exposing a second portion of the first pressure sensitive adhesive layer; and bringing the bound stack and the second portion of the first pressure sensitive adhesive layer into contact with one another; and wherein the second hardcover section of the hardcover assembly further includes a second pressure sensitive adhesive layer and wherein the method further includes: exposing only a first portion of the second pressure sensitive adhesive layer; positioning the bound stack and the second hardcover section so that the bound stack comes in contact with the exposed first portion of the second pressure sensitive adhesive layer; exposing a second portion of the second pressure sensitive adhesive layer; and bringing the bound stack and the second portion of the second pressure sensitive adhesive layer into contact with one another.

37. Ong teaches providing a hardcover assembly 90 including first 94 and second 92 relatively rigid hardcover sections separated by a spine segment 24, with the first hardcover section 94 including a first pressure sensitive adhesive layer 114/112; exposing only a first portion 114 of the first pressure sensitive adhesive layer; positioning the bound stack 12 and the first hardcover section 94 so that the bound stack comes in contact with the exposed first portion 114 of the first pressure sensitive adhesive layer; exposing a second portion 112 of the first pressure sensitive adhesive

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layer; and bringing the bound stack 12 and the second portion 112 of the first pressure sensitive adhesive layer into contact with one another. Ong further teaches wherein the second hardcover section 92 of the hardcover assembly further includes a second pressure sensitive adhesive layer 102/104 and wherein the method further includes: exposing only a first portion 102 of the second pressure sensitive adhesive layer; positioning the bound stack 12 and the second hardcover section 92 so that the bound stack comes in contact with the exposed first portion 102 of the second pressure sensitive adhesive layer; exposing a second portion 104 of the second pressure sensitive adhesive layer; and bringing the bound stack 12 and the second portion 104 of the second pressure sensitive adhesive layer into contact with one another, all for the purpose of providing a relatively rigid hardcover to the bound stack 12. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the binding apparatus of DuCorday with the hardcover element of Ong in order to have a book that has a more protective cover.

### ***Conclusion***

38. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric A. Gates whose telephone number is 571-272-5498. The examiner can normally be reached on Monday-Thursday 7:45-6:15.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



EAG  
8 February 2006



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